



UNITED STATES PATENT AND TRADEMARK OFFICE

W
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,995	02/09/2001	Ken Kutaragi	SCEI 18.302	5881

7590 08/09/2007
KATTEN MUCHIN ZAVIS ROSENMAN
575 MADISON AVENUE
NEW YORK,, NY 10022-2585

EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
----------	--------------

3622

MAIL DATE	DELIVERY MODE
-----------	---------------

08/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/780,995	KUTARAGI ET AL.	
	Examiner Raquel Alvarez	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 June 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 2/22/07, 6/13/07.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date: _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 6/12/2007.
2. Claims 21-25 have been added with this amendment. Claims 1-25 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (5,835,087 hereinafter Herz).

With respect to claims 1, 4-6, 8, 11-18, 21-25 Herz teaches an in contents-advertising method wherein advertisement information provided beforehand is included in digital contents activated by a user terminal (Summary). Activating in a user terminal in a program by a user the digital content and determining that the digital contents have been activated by the user (col. 55, lines 45-54); transferring an identifier of the digital contents and an identifier of the user to an advertising information server when the digital contents have been activated by the user (col. 55, lines 45 to col. 56, lines 1-14); selecting and retrieving advertising information by the advertising information server based on the digital contents identifier and the user identifier and transferring the retrieved advertising information to the user terminal (col. 60, lines 11-20); inserting the retrieved advertising information in the digital contents such that the advertising

Art Unit: 3622

information is automatically selected and retrieved from the advertising server, transferred to the user terminal and inserted in the digital contents when the digital contents are activated in the user terminal by the user (col. 55, lines 45 to col. 56 lines 1-14; col. 60, lines 11-20 and col. 61, lines 4-26); information indicating that advertisements may be inserted, advertising information included in the digital content is updated with the retrieved advertising information. In Herz, the lists of advertisements are pre-selected based on the target profile of the article (col. 55, lines 50-62) and the amount that advertisers are willing to pay (col. 40, lines 8-28); receiving input from the user via a user interface of the program after transferring of the retrieved advertising information. In Herz, the advertisements are selected and retrieved based on target profile of the news programs (col. 55, lines 50-62) and based on the amount of money the advertisers are willing to pay (col. 40, lines 8-28). The advertisements are pre-selected before the user interacts with the new news program.

With respect to the digital contents being activated in a game program. Herz teaches the content is activated in a news service program. It would have been obvious to a person of ordinary skill in the art to have changed the news service program of Herz to a game program in order to attract fun, younger users to the system.

With respect to counting the number of times that the retrieved advertising information is transferred. Official Notice is taken that it is old and well known to count the number of times that a user clicks on advertisements in order for advertisers to get billed only for advertisements that are received. It would have been obvious to a person

of ordinary skill in the art at the time of Applicant's invention to have included counting the number of times that the retrieved advertising information is transferred in order for the advertisers to be billed for ads that have been retrieved.

With respect to claims 2-3, Herz further teaches providing the advertising information by the advertising server to the contents provider for insertion in the digital contents (Figure 1).

Claims 7 and 9, further recite advertising fees based on said recording results. Official notice is taken that it is old and well known to charge based on recording/product quality. For example, a low/inferior quality recording or product gets a lower fee than a high quality product or recording in order to compensate for good performance. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertising fees based on said recording results in order to obtain the above mentioned advantages.

Claim 10 further recites the advertisers providing the times of the advertisement insertion and providing said ads based on said advertisements information specified from said advertiser. Official notice is taken that it is old and well known for advertisers to select the times slots and structure in which they want the advertisements to be displayed to the customers. It would have been obvious to a person of ordinary skill in

Art Unit: 3622

the art at the time of Applicant's invention to have included the advertisers providing the time of the advertisements insertion because such a modification would allow the advertisers to target the proper audience based on the time period selected.

Claim 19 further recites a moving image as the advertising information. Official Notice is taken that it is old and well known for digital contents to be presented as moving objects or the like in order to provide a continuously changing position of the content and therefore provide a more realistic presentation of the information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a moving image as the advertising information in order to achieve the above mentioned advantage.

Claim 20 further recites that the program a driving game program and it includes a vehicle operated by the user. Official Notice is taken that it is old and well known for game programs and the like to provide different life like features such as vehicles and allowing the user to drive or manipulate these features in order to provide a life like experience for the users. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the program being program a driving game program and it includes a vehicle operated by the user in order to achieve the above mentioned advantage.

Response to Arguments

4. With respect to the Official Notice taken, Applicant states that even though each individual recited element may be known, Applicant states that the conglomeration of these features in digital contents as recited in claim 1 are not known in the art. The Examiner wants to point out that the claims were rejected under the doctrine of 103 and the Examiner has presented motivation that the combination of the well known features in digital contents would have been obvious at the time of Applicant's invention and therefore the rejection is been sustained.

5. With respect to the newly added feature of counting the a number of times that the retrieved advertising information is retrieved. The Examiner wants to point out that it makes sense in the system of Herz to not just purchase a right to include ads in a set but to also determine the number of times that an advertisement is presented because it would help determine how many times an advertisement has to be presented in order to be effective and for advertisers to be billed for the times that an ad is presented.

6. With respect to the motivation to change Herz "news program" to "a game program" as claimed would have been obvious in order to provide fun and excitement in the system which would lead to attracting younger audience as previously stated by Examiner. Applicant argues that the motivation is improper but the Examiner disagrees with Applicant because as we all know usually news program and the like try to attract new, young audience by making the programs fun and exciting.

7. With respect to the arguments pertaining to the Official Notice, Applicant hasn't provided a proper challenge that would that would at least cast reasonable doubt on the

Art Unit: 3622

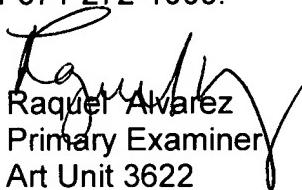
fact taken notice. Merely asking for a reference is not enough. Applicant has to provide reasoning or proper challenge as how the features taken official notice of were not known at the time of Applicant's invention.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Raquel Alvarez
Primary Examiner
Art Unit 3622

Application/Control Number: 09/780,995
Art Unit: 3622

Page 8

R.A.
8/1/2007